REMARKS

1. Claims 1-33 are presently pending. The Examiner has rejected claims 1-33 under 35 U.S.C. § 103(a) as being unpatentable over Kondo et al., "Surfin' the World Wide Web in Japanese" (hereinafter "Kondo"), in view of U.S. Pat. No. 5,913,196 to Talmor et al. ("Talmor"). Tracking the language of the present Claim 1, the Examiner states in the rejection that Kondo discloses "a method for recognizing voice commands for manipulating data on the Internet, comprising the steps of:," and also discloses "providing data on a website on the Internet," "receiving voice signals from a user accessing the website," "interpreting the voice signals of the user for determining navigational commands," and "outputting selected data of the website based on the navigational commands." The Examiner also states that Kondo fails to explicitly establish the identity of the user through the voice signals.

The Examiner then states that this feature is well known in the art, as evidenced by Talmor, which discloses a method for identifying a person's identity over a secured network. Again tracking the language of Claim 1, the claimed step is for "establishing an identity of the user through at least two authentication algorithms." The Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Talmor's voice identification system in Kondo's voice browser.

2. Applicant traverses this rejection on the grounds that the Examiner has not established a prima facie case of obviousness. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143.

Applicant believes that the combination of the two references is improper. A person having ordinary skill would not be motivated to combine Kondo's voice command recognition with Talmor's voice authentication system, since they are contradictory. Prior art must be

considered in its entirety, including portions that teach away from the claims. M.P.E.P. 2141.02 at 2100-120.

Kondo concerns browsing the Internet via voice commands to Internet sites that have been bookmarked. Kondo, p. 1154, col. 2, lines 11-15. The essence of the Kondo article, entitled, "Surfin' the World Wide Web with Japanese," is that voice recognition will make the Internet easier to navigate and will thus attract more users. *See* Kondo, p. 1151, col. 2, lines 17-25, stating,

> with a gradual resolution of these problems, we are seeing a sudden increase in traffic and the number of Web pages written in Japanese has increased drastically. The general Japanese population, which had much lower access to computers compared to the U.S., has suddenly started using keyboards. If these naïve users were allowed to use speech to access the Web, they would have a much smoother introduction to the computer and the internet.

There is no suggestion in Kondo that access should be restricted. There is no mention in Kondo of voice authentication.

In contrast to Kondo's focus on increased access through voice recognition navigation, the Talmor patent is directed to restricting access through voice authentication algorithms once a computer is accessed, not necessarily through the Internet. *See* Talmor, col. 3, lines 23-35 (stating that the system comprises a computerized system including at least two voice authentication algorithms); and lines 60-65 (stating that the remote communications of this invention include wire telephone, cellular telephone, radio communication, and computer phone communication including the Internet). There is no mention in Talmor of "interpreting the voice signals of the user for determining navigation commands." Talmor is limited to providing access to a secured site, using two voice authentication algorithms. Talmor does not mention voice-command navigation, and one having ordinary skill in the art is not motivated to provide voice-command navigation, since Talmor also teaches direct-connected access to secure computerized systems. *See* Figs. 2-5 and col. 3, lines 60-65.

3. In order to combine references, there must be some suggestion or motivation to modify the reference or to combine reference teachings that outweighs any portion of the references that teach away from the combination. As an example, in one recent court ruling concerning a patent for purifying water, the Court of Appeals for the Federal Circuit found clear error in a district court's finding that there was motivation to combine the asserted prior art references, and reversed the district court's finding of obviousness. Ecolochem v. Southern Calif. Edison, 56 U.S.P.Q.2d 1065, 1066 (Fed. Cir. 2000). The district court combined references: (1) an article from 1957 that discussed deoxygenating water using hydrazine and (2) several additional references that used hydrogen and ion-exchange methods. Id. at 1072. These other references, however, found problems in the combination, and actually taught away from the combination. Id. at 1074-75. One reference in particular compared a process that used hydrazine unfavorably with a process that used hydrogen, thus teaching away from the claimed invention. Id. at 1074. Therefore, the Court of Appeals for the Federal Circuit held that one of ordinary skill in the art would not have combined the references, and it was clear error to find that there was a suggestion to combine the references. Id. at 1076.

In *Ecolochem,* there was no motivation to combine the references because the combination taught away from the claimed invention. The contradictory teachings outweighed any possible motivation to combine the references. In seeking to combine references here, the Examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. M.P.E.P. 2143.01, at 2100-124 to 2100-125. In the present application, the references are inherently contradictory, in that Kondo seeks to make it easier to access the Internet, while Talmor seeks to restrict access. The two contradictory references outweigh the motivation asserted by the Examiner for combining the references to arrive at the claimed invention.

As a reason for combining the references, the Examiner states that it would have been obvious to combine the references using Talmor's voice recognition system in Kondo's voice

browser because "Talmor et al. teach one of ordinary skill in the art the benefit of using two voice verification methods to reliably restrict access to a network to unauthorized user." Office Action, p. 3, lines 6-7. However, the Examiner must consider the other teachings of the two references being combined. First, in contrast to Talmor's disclosure, Kondo does not describe or suggest even a single voice authentication system, let alone two different voice authentication systems. Second, Kondo would suggest not making the combination with Talmor, because Kondo is providing is directed to increasing user's access, while Talmor would limit access to web sites. Third, Talmor does not teach surfin' on the Internet, because Talmor is only interested in accessing remote, highly secure, specific sites. One of ordinary skill in the art would understand that persons desiring to navigate the web want greater access and fewer restrictions, while persons maintaining secured sites or accessing secured sites desired highly limited access.

A rejection cannot be predicated on the mere identification of individual components of claimed limitations; particular findings must be made as the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these particular components for a combination in the manner claimed. In re Kotzab, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). The Examiner has not given a sufficient motivation for combining the references which outweighs the contradictory teachings concerning the level of access for users on the Internet. The prior art must be considered in its entirety, including portions that would lead away from the claimed invention. M.P.E.P. § 2141.02. Therefore, the first condition stated in M.P.E.P. § 2143 for establishing a prima facie case of obviousness, the motivation for combining the references, is not met.

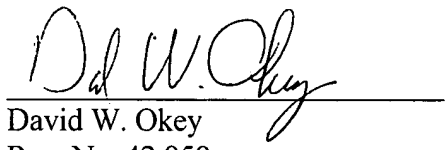
4. Applicant believes that the Examiner's rejection over Kondo in view of Talmor is improper. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejections under 35 U.S.C. § 103(a) and to advance the claims to allowance. The present claims are patentable over Kondo in view of Talmor because the references properly taken in their entirety

do not disclose or suggest combining the use of two different algorithms for authenticating the identification of a user as claimed and interpreting the voice signals of the user for determining navigation commands.

CONCLUSION

5. Applicant requests that the Examiner withdraw the rejections, and advance the claims to allowance. If the Examiner would like to discuss the response, the Examiner is respectfully requested to call the undersigned at 312-321-4711.

Respectfully submitted,



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